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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,264	04/19/2002	Tomomi Ikemoto	2001-1899A	1319

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,264

Applicant(s)

IKEMOTO ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 16-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group I, Claims 1-10 and 15, drawn to a method for producing a compound of the formula with all the variables are as defined except optionally substituted heterocyclic group. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, the requirement for restriction in Paper No. 9 is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Status of Claims

Claims 1-48 are pending in this application. Claims 11-14 and 16-48 are withdrawn from consideration by the Examiner under 37 C.F.R. 1.142 (b) as directed to non-elected subject matter.

Generic concept

As set forth in the restriction requirement, the election of Group I has resulted in the following the generic concept.

A method for producing a compound of the formula of claim 1 wherein:

R^{a1} and R^{a2} are each a hydrogen atom, a substituted hydroxy, a substituted thiol, a substituted amino, and an optionally substituted hydrocarbon group or an acyl

R^{a3} is as claimed except "an optionally substituted heterocyclic group"

R^{a4} and R^{a5} are as claimed

R^{a6} is an optionally substituted aromatic group

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m^a is as claimed

R^{a7} and R^{a8} are each a hydrogen atom, a halogen, an optionally substituted hydroxy, an optionally substituted thiol, an optionally substituted amino, and an optionally substituted hydrocarbon group or an acyl.

As a result of the election and the corresponding generic concept identified, claims 11-14 and 16-48 and the remaining subject matter of claims 1-10 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 11-14 and 16-48 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

Claim Objections

Claims 1-10 and 15 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. The claims must be amended to exclude non-elected subject matter and within the limit of the elected compound and all the dependent claims also, must be amended to satisfy the restriction requirement in order to place the case in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The Examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone

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number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.


When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

Golam M M Shameem, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1

March 26, 2003


Joseph K McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1